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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,162	01/18/2002	Siu Choon Ng	4810-62169	5351

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EXAMINER

THERKORN, ERNEST G

ART UNIT PAPER NUMBER

1723

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/054,162

Applicant(s)

NG ET AL.

Examiner

Ernest G. Therkorn

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 35-37, 45 and 48-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35-37, 45 and 48-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35-37, 45, and 48-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lincoln (U.S. Patent No. 5,324,750) in view of Ng (U.S. Patent No. 6,017,458) and either Armstrong (Anal. Chem. 1990, 62, 1610-1615) or Hargitai (Journal of Chromatography, 628 (1993), pages 11-22). At best, the claims differ from Lincoln (U.S. Patent No. 5,324,750) in the clarity of reciting a saccharide that is fully functionalized and a moiety that is able to bind to a support. Armstrong (Anal. Chem. 1990, 62, 1610-1615) (page 1610, column 2, line 15-page 1611, column 1, line 8 and the paragraph under "Results and Discussion" on page 1611, column 2) discloses it is desirable to maximize the functionalization of cyclodextrin because that increases its ability to resolve enantiomers under normal phase conditions. Hargitai (Journal of Chromatography, 628 (1993), pages 11-22) (Abstract and page 22, lines 6-11) discloses that maximizing functionalization was the most important factor for enantioselectivity. Ng (U.S. Patent No. 6,017,458) (column 2, lines 10-19; column 2, line 60-column 3, line 6; and column 3, lines 41-51) discloses forming a silane derivative results in a product that is universally applicable to HPLC, LC, TLC, and CLE and permits immobilization on a support material surface. It would have been obvious to fully functionalize the cyclodextrin in Lincoln (U.S. Patent No. 5,324,750) either because Armstrong (Anal. Chem. 1990, 62, 1610-1615) (page 1610, column 2, line 15-page

1611, column 1, line 8 and the paragraph under "Results and Discussion" on page 1611, column 2) discloses it is desirable to maximize the functionalization of cyclodextrin because that increases its ability to resolve enantiomers under normal phase conditions or because Hargitai (Journal of Chromatography, 628 (1993), pages 11-22) (Abstract and page 22, lines 6-11) discloses that maximizing functionalization was the most important factor for enantioselectivity. It would have been obvious to form a silane derivative for binding in Lincoln (U.S. Patent No. 5,324,750) because Ng (U.S. Patent No. 6,017,458) (column 2, lines 10-19; column 2, line 60-column 3, line 6; and column 3, lines 41-51) discloses forming a silane derivative results in a product that is universally applicable to HPLC, LC, TLC, and CLE and permits immobilization on a support material surface.

The remarks urge that there is no reasonable expectation of success combining Lincoln (U.S. Patent No. 5,324,750) and Ng (U.S. Patent No. 6,017,458) because Lincoln (U.S. Patent No. 5,324,750) is limited to a particular type of linker. However, Lincoln (U.S. Patent No. 5,324,750) discloses linking to a support on column 19, line 34-column 20, line 24. The only requirement of Lincoln (U.S. Patent No. 5,324,750)'s column 20, line 6 linker is that it is suitable. As such, there is a reasonable expectation of success of using Ng (U.S. Patent No. 6,017,458)'s linker in Lincoln (U.S. Patent No. 5,324,750).

The remarks urge that Ng (U.S. Patent No. 6,017,458) (column 2, lines 10-19; column 2, line 60-column 3, line 6; and column 3, lines 41-51) does not disclose forming a silane derivative results in a product that is universally applicable to HPLC, LC, TLC,

and CLE and permits immobilization on a support material surface. However, Ng (U.S. Patent No. 6,017,458) (column 2, lines 10-19) discloses that his linkages are universally applicable to HPLC, LC, TLC, and CLE. A fair reading of Ng (U.S. Patent No. 6,017,458) (column 2, line 60-column 3, line 6 and column 3, lines 41-51) indicates that those linkages are formed with silanes. As such, Ng (U.S. Patent No. 6,017,458) (column 2, lines 10-19; column 2, line 60-column 3, line 6; and column 3, lines 41-51) discloses forming a silane derivative results in a product that is universally applicable to HPLC, LC, TLC, and CLE and permits immobilization on a support material surface.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to E. Therkorn at telephone number (571) 272-1149. The official fax number is (703) 872-9306.

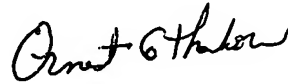
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Ernest G. Therkorn**  
**Primary Examiner**  
**Art Unit 1723**

EGT  
April 27, 2005